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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,430	06/28/2001	Ryuji Iwakiri	Q65021	2865
7590 11/07/2003				
Sughrue Mion Zinn Macpeak & Seas 2100 Pennsylvania Avenue NW Washington, DC 20037-3213			EXAMINER SHORT, PATRICIA A	
			ART UNIT 1712	PAPER NUMBER

DATE MAILED: 11/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/869,430	IWAKIRI ET AL.	
	Examiner	Art Unit	
	Patricia A. Short	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4 and 5 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1, 2</u> . | 6) <input type="checkbox"/> Other: |

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This action is in response to the request for continued examination (RCE) and preliminary amendment filed on September 15, 2003.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami.

The rejection is applied as in the Office Action mailed December 5, 2002. It is not seen how the language "essential components" defines over any amount of the fluoroolefin and vinyl versatate present in the vinyl polymer of the reference. With respect to the arguments directed to unexpected results, as disclosed at page 6, lines 11-13 and page 10, lines 10-14, the vinyl ester must be from 1 to 30 % by weight to obtain weather resistance and compatibility in the polyester and the fluorine content must be not less than 10 % by weight for weather resistance.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami alone or in view of Foukes. Murakami teaches a thermosetting powder coating that comprises polyester having reactive groups, a thermosetting vinyl polymer having reactive groups that may be prepared from fluorine containing monomer (col. 4, lines 30-31) and a curing agent. The reference does not specify 1,4-cyclohexane dicarboxylic acid as an acid for use in preparing the polyester, but does teach that the polyester can be prepared using conventional polybasic acid. See col.2, lines 40-44. Foukes discloses that 1,4-cyclohexane dicarboxylic acid and other acids specifically disclosed by Murakami can be used to prepare polyesters that are used in a thermosetting powder coating. See col. 4, lines 1-6. As 1,4-cyclohexane dicarboxylic acid is a conventional dicarboxylic acid used to prepare polyesters, it would have been obvious to use as

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the dicarboxylic acid in the polyester of Murakami. Alternatively, in view of Foukes disclosing 1,4-cyclohexane dicarboxylic acid as an equivalent of dicarboxylic acids specifically taught by Murakami, it would have been obvious to use 1,4-cyclohexane dicarboxylic acid as the dicarboxylic acid in the polyester of Murakami.

Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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October 30, 2003

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